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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,748	05/19/2004	Yoram Cedar	SNDK.158US2	8576
36257	7590	09/08/2004	EXAMINER	
PARSONS HSUE & DE RUNTZ LLP 655 MONTGOMERY STREET SUITE 1800 SAN FRANCISCO, CA 94111			AUVE, GLENN ALLEN	
			ART UNIT	PAPER NUMBER
			2111	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Handwritten mark/signature

Office Action Summary

Application No.

10/849,748

Applicant(s)

CEDAR ET AL.

Examiner

Glenn A. Auve

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/19/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because it is not clear whether "when connected to all of the plurality of sockets" refers to the card or the host.

Claim 1 is also rejected based on lack of positive antecedent basis of "the electronic circuit cards" on lines 7-8 and "the cards" on lines 10-11. The claim only recites that cards are connectable and insertable into the sockets, but no cards are actually positively recited.

Claims 2-4 are rejected because they depend on claim 1.

Claim 2 is also rejected based on lack of positive antecedent basis of "the electronic circuit cards" on line 2, and "the cards inserted into the plurality of sockets" on lines 5-6.

Claim 4 is also rejected based on lack of positive antecedent basis of "the electronic circuit cards" on lines 1-2.

Claim 5 is rejected based on lack of positive antecedent basis of "said at least one card inserted into said at least one socket" on lines 6-7; "said at least one inserted card" on line 8; and "the individual one inserted card" on line 10. The claim only recites that cards are removably insertable into the at least one socket, but no cards are actually positively recited as actually being inserted.

Claims 6-9 are rejected because they depend on claim 5.

Claim 6 is also rejected based on lack of positive antecedent basis of "said at least one plurality of sockets" on line 2.

Claim 9 is also rejected based on lack of positive antecedent basis of "said at least one inserted card" on line 2.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 5-9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5-9 of copending Application No. 09/641,023. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented, however the parent application has been allowed and the issue fee has been paid.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/641,023. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only real difference in the claims is that the allowed claims in the parent application have been amended to recite that the cards are actually inserted into the sockets not just insertable. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to actually insert cards into the sockets in which they are insertable in order to use the cards in the system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-20 and 24-32 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by the SD Memory Card Specifications Part 1 Physical Layer Specification Version 1.0, March 2000 (SD specification 1.0), submitted by applicant in the parent application.

As a preface to this rejection, the examiner notes that applicant has filed the above identified SD Card specification reference in the parent case along with a declaration under 37 CFR §1.132 by the applicants. However no such declaration has been filed in the present application so the art is being applied.

As per claim 1, the SD Specification 1.0 shows a host a plurality of sockets in which cards are insertable, and transferring data between the host and a card addressed over a command circuit connected between the host and the sockets and the data being transferred through a data circuit, and normally transferring control operations of the cards from the host to a card over the command circuit connected between the host and the sockets except when unique addresses of individual cards are being defined by communication between the host and the cards one at a time over the command circuit which is connected to the sockets one at a time (at least in section 3.1.1 and also on page 20). The SD Card specification shows all of the elements recited in claim 1.

As for claim 2, the argument for claim 1 applies. The SD Card specification also shows storing within the cards a characteristic of a number of data contacts through which data are transferable in parallel, causing the host to read the stored characteristic of the cards, and transferring data between the host and the card includes transferring data over one or more of the data lines connecting the host with the sockets according to the stored characteristic (the "set_bus_width" command as noted at least in section 4.3.1 and page 44). The SD Card specification shows all of the elements recited in claim 2.

As for claim 3, the argument for claim 2 applies. The SD Card specification also shows that the host provides a clock signal to each socket to operate the cards with a common frequency clock signal (at least in section 4.4). The SD Card specification shows all of the elements recited in claim 3.

As for claim 4, the argument for claim 1 applies. The SD Card specification also shows that the cards include re-writeable non-volatile memory in which transferred data are stored (throughout the specification, at least in section 3). The SD Card specification shows all of the elements recited in claim 4.

As per claim 5, the SD Card specification shows storing within the individual cards a characteristic of a number of data contacts through which data are transferable in parallel; causing the host to read the stored characteristic from the card inserted in a socket, and transferring data between the host and the card over one or more of the plurality of lines according to the characteristic stored in the card (the "set_bus_width" command as noted at least in section 4.3.1 and page 44). The SD Card specification shows all of the elements recited in claim 5.

As for claim 6, the argument for claim 5 applies. The SD Card specification also shows that the host provides a clock signal to each socket to operate the cards with a common frequency clock signal (at least in section 4.4). The SD Card specification shows all of the elements recited in claim 6.

As for claim 7, the argument for claim 6 applies. The SD Card specification also shows that the cards include re-writeable non-volatile memory in which transferred data are stored (throughout the specification, at least in section 3). The SD Card specification shows all of the elements recited in claim 7.

As for claim 8, the argument for claim 7 applies. The SD Card specification also shows that the host determines whether the inserted card is an MMC type and if so transfers data over only one of the data lines (page 20). The SD Card specification shows all of the elements recited in claim 8.

As for claim 9, the argument for claim 7 applies. The SD Card specification also shows that transferring data includes directing individual bits of a serial data stream in sequence through a number of data lines corresponding to the characteristic stored in the card (the "set_bus_width" command as noted at least in section 4.3.1 and page 44). The SD Card specification shows all of the elements recited in claim 9.

9. Claims 1 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art.

As per claim 1, Applicant's Admitted Prior Art (AAPA) shows a host a plurality of sockets in which cards are insertable, and transferring data between the host and a card addressed over a command circuit when the host is connected to all of the sockets, and normally transferring control operations of the cards from the host to a card when connected to all of the sockets except when unique addresses of individual cards are being defined by communication between the host and the cards one at a time over the command circuit which is connected to the sockets one at a time (fig. 3 and pages 9-10, wherein the cards have their unique addresses assigned one at a time to their relative card address registers). AAPA shows all of the elements recited in claim 1. The procedure for assigning addresses to the cards is also described in the multimedia card specification.

As for claim 4, the argument for claim 1 applies. AAPA also shows that the cards include re-writeable non-volatile memory in which transferred data are stored (pages 9-10). AAPA shows all of the elements recited in claim 4.

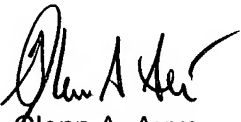
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner will be moving on October 13, 2004. After that date the telephone number will be (571) 272-3623. The examiner can normally be reached on M-Th 8:00 AM-5:30 PM, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2111

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn A. Auve
Primary Examiner
Art Unit 2111

gaa
September 3, 2004